

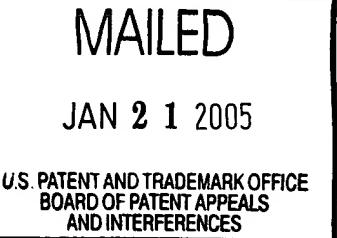
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TORU MATAMA

Appeal No. 2004-2264
Application 09/374, 989



HEARD: January 12, 2005

Before PAK, OWENS, and DELMENDO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claim 4, which is the sole pending claim.

THE INVENTION

The appellant claims a photographic photosensitive material

that is dedicated for digital data processing and has, as indicated by an identification code, either a color correction function or a sharpness enhancing function. Claim 4 is as follows:

4. A photographic photosensitive material dedicated for digital data processing which has a color correcting function for carrying out color correction of an image which has been subjected to developing processing or a sharpness enhancing function for enhancing sharpness of the image which has been subjected to developing processing, wherein an identification code for digital processing is recorded optically or magnetically onto said photographic photosensitive material, or is recorded onto a storage element provided at a cartridge accommodating said photographic photosensitive material, said identification code expressing that said photographic photosensitive material either has said color correction function or said sharpness enhancing function, and

when said photographic photosensitive material has said color correcting function, said color correcting function is due to at least one of a colored coupler and an interimage effect, or

when said photographic photosensitive material has said sharpness enhancing function, said sharpness enhancing function is due to a DIR coupler, and

said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time.

THE REFERENCES

Nair et al. (Nair)	5,753,426	May 19, 1998
Bohan et al. (Bohan)	5,837,433	Nov. 17, 1998
Suzuki et al. (Suzuki)	6,094,218	Jul. 25, 2000 (filed Jul. 7, 1997)

THE REJECTIONS

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bohan in view of Suzuki and over Bohan in view of Nair.¹

OPINION

We affirm the aforementioned rejections.

Suzuki discloses a photographic photosensitive material wherein the layers typically contain both a color masking coupler (which is the appellant's colored coupler) and a development inhibitor releasing (DIR) coupler (col. 11, lines 52-56 and 62-65; col. 12, lines 51-55; col. 13, lines 7-11). Bohan, however, teaches that "[r]elying on the digital correction step to provide color correction obviates the need for color masking couplers in the elements" (col. 10, lines 34-36). Bohan, therefore, would have fairly suggested, to one of ordinary skill in the art, a photographic photosensitive material containing a DIR coupler but no color masking coupler.

¹ The examiner relies upon additional prior art in the examiner's answer (page 6). Because that prior art is not included in a rejection, it is not properly before us. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Consequently, we do not consider that prior art in reaching our decision.

Bohan does not disclose an identification code, on either the photographic photosensitive material or its enclosing cartridge, that indicates whether the photographic photosensitive material includes a color masking coupler. However, Bohan's above-cited disclosure would have indicated to one of ordinary skill in the art that the system that digitally processes the photographic photosensitive material must be informed that the photographic photosensitive material contains no color masking coupler and that, therefore, the color correction must be provided by the digital correction step. One method known in the art for providing information as to how photographic photosensitive material is to be processed was to place an identification code on the photographic photosensitive material as indicated by Suzuki (col. 6, lines 21-36) and Nair (col. 5, lines 2-23). Consequently, the applied prior art would have fairly suggested, to one of ordinary skill in the art, placing on Bohan's photographic photosensitive material an identification code that indicates either that the photographic photosensitive material contains a color masking coupler or that the digital correction step is to be used for color correction.

The appellant argues that Bohan does not disclose a photographic photosensitive material that is dedicated to digital processing (brief, pages 14-16). Like the appellant's photographic photosensitive material that contains a DIR coupler but no color masking coupler, Bohan's photographic photosensitive material that contains a DIR coupler but no color masking coupler is dedicated to digital processing.

The appellant argues that Bohan does not affirmatively prohibit a color masking coupler and a DIR coupler from both being present in the photographic photosensitive material (reply brief, page 2). The appellant is correct. However, as discussed above, Bohan would have fairly suggested, to one of ordinary skill in the art, a photographic photosensitive material that contains a DIR coupler but no color masking coupler.

For the above reasons we conclude that the appellant's claimed invention would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

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DECISION

The rejections of claim 4 under 35 U.S.C. § 103 over Bohan in view of Suzuki and over Bohan in view of Nair are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

Chung K. Pak
CHUNG K. PAK)
Administrative Patent Judge)
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)
Terry J. Owens)
TERRY J. OWENS)
Administrative Patent Judge)
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Romulo H. Delmendo)
ROMULO H. DELMENDO)
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